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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,844	12/21/2001	Juergen Mannss	016790-0445	5748
22428	7590	03/09/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/023,844	Applicant(s) MANNSS, JUERGEN	
	Examiner Thong Q. Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 and 11 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of the species shown in figures 1-2 in the election filed on 12/24/2003 is acknowledged. It is noted that in the election, applicant has stated that the claims readable from the elected species of figures 1-2 are claims 1-8 and 10-40. However, a careful search of the inventive device as claimed in independent claims 1, 13 and 36 has resulted that the use of light reflected from a specimen for illuminating a display and superimposing the signal provided by the display into the viewing path of the optical device is patentable with respect to the prior art; therefore, all of the claims directed to non-elected species is/are now rejoined by the Examiner and also examined in this Office action.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings were received on 4/11/2002 in which applicant has amended figures 1-2 and 3a. It is noted that the amendment to figure 3a is agreed by the Examiner and the amendments to figures 1-2 are not agreed by the examiner because the deletion of the changeover/switch of the element (17) with respect to the second light source (18) will make the feature(s) claimed in the present claims as the ones which do not have support in the drawings. See further details in the Objection to the Drawings set forth below.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features recited in the claim(s) must be shown feature or the feature(s) canceled from the claim(s). No new matter should be entered.

First, the feature relating to the illumination for the reflected-in image by both a main light source and a secondary light source as recited in claim 1, last four lines of the claim;

Second, the feature relating to the switching of the optical prism for selecting a main light source or a secondary light source as recited in claim 3, lines 1-3 and claim 24, lines 1-3;

Third, the feature relating to the mechanism/electronics used to control the brightness of the reflected-in image as recited in claim 5 (lines 1-2);

Fourth, the feature relating to the use of a diaphragm as recited in claims 7 and 31 (line 2 of each claim);

Fifth, the feature relating to the additional light source for amplifying the intensity of light or the residual light amplifier recited in claim 8, lines 2-3 and claim 19, lines 1-3.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The substitute specification filed by the applicant on 4/11/2002 has been received and enter. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
6. The disclosure is objected to because of the following informalities: The Summary of the Invention is objected to because it fails to comply with the requirements as set forth in 37 CFR 1.73 which requires that the Summary of the invention is a brief technical description of the inventive device. See also MPEP, section 608.01(d). Applicant should provide a brief description of the invention and move other details to different sections such as Detailed Description of the Invention, etc... Appropriate correction is required.

Claim Objections

7. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim is objected to because it recites a reflective display while the base claim 1 recites a transmitted display.
8. Claims 37-39 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

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Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

a) Each of claims 37 and 38 recites that the illumination of a display is made by either a direct main light source illumination or an indirect main light source illumination (claim 37) or the illumination of a display is made by either a main light source illumination or a secondary light source illumination (claim 38); however, the base claim 36 recites that the illumination of the display is made by an indirect main light source illumination.

b) Claim 39 is dependent upon an objected base claim and thus inherits the deficiency thereof.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-8 and 10-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) The device as claimed in claim 1 recites that the illumination for the reflected-in image is made by a main light source and/or a secondary light source.

Regarding to the illumination for the purpose of providing a reflected-in image to

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the microscope, applicant has disclosed the use of an optical element labeled as "17" in figures 1 and 2. However, there is not any description or information relating to the structure of the optical element (17) so as one skilled in the art can be figure out how the optical element can be used for selection the main light source or the secondary light source and how the optical element can be used when both main light source and the secondary light source are used as recited in the feature thereof "the illumination for...of the main light source (11) and/or a secondary light source (18) controllable as a function of the main light source" (claim 1, last four lines of the claim).

b) Claim 8 is rejected under 35 USC 112, first paragraph because the specification does not disclose the use of a main light source, a secondary light source and an additional light source for amplifying the intensity of light on the display as claimed.

c) The device as claimed in claim 13 is rejected under 35 USC 112, first paragraph for the similar reason as set forth in element a) above. In particular, there is not any description or information relating to the structure of the optical element (17) so as one skilled in the art can be figure out how the optical element can be used for selection the main light source or the secondary light source and how the optical element can be used when both main light source and the secondary light source are used as recited in the feature thereof "the optical signal...light source illumination and both" (claim 13, lines 8-10 of the claim).

d) Claim 19 is rejected for the similar reason as set forth in element c) above.

e) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-8 and 10-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: First, the use of the phrase "for example" (line 2) and the phrase "in particular" (line 5) renders the claim indefinite because it is unclear whether the limitation(s) following each of the mentioned phrases are part of the claimed invention. See MPEP § 2173.05(d); Second, the recitation thereof "wherein the illumination...main light source" (lines 4-7) is unclear because it is unclear about the structure of the second light source and the main light source so that the second light source is controlled as a function of the main light source as claimed.

b) Claim 3 is rejected under 35 USC 112, second paragraph because the phrase "or the like" (line 2) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

c) Claim 5 is rejected under 35 USC 112, second paragraph because it is unclear about the manner or the system being used to control the brightness of the reflected-in image light source by the recitation thereof "the brightness of...overwritable fashion" (lines 1-3).

d) Regarding claim 8, the phrase "in particular" (line 2) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

e) Regarding claim 10, the phrases "preferably" (line 1) and "optionally" (line 4) render the claim indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

f) Claim 11 is indefinite. The phrase "or the like" (line 2) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

g) Claim 13 is rejected under 35 USC 112, second paragraph for the following reason. The recitation thereof "wherein the illumination...main light source" (lines 4-7) is unclear because it is unclear about the structure of the second light source and the main light source so that the second light source is controlled as a function of the main light source as claimed.

h) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

Allowable Subject Matter

13. Claims 36 and 40 are allowed over the cited art.

14. Claims 1-8 and 10-35 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

15. The following is an examiner's statement of reasons for allowance:

The device as claimed in each of independent claims 1, 13 and 36 is patentable with respect to the cited art, in particular, the U.S. Patent Nos. 5,601,549; 6,097,538; 6,081,371 and 5,835,263 by the limitations relating to the illumination system for illuminating a display so that the image of the display is projected into the viewing path of the optical device. It is noted that the use of an illuminating system for illuminating a display and then projecting the image of the display into the viewing path of an optical device is well known to one skilled in the art; however, the cited art does not disclose that the display is illuminated by light reflected from a specimen as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

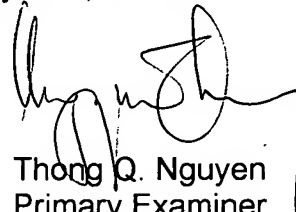
Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
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